

REMARKS/ARGUMENTS

Applicant has amended the claims to emphasize the differences between the claimed skylight and the greenhouse tray cover of U.S. Patent No. 4,236,350 (the "Hasselbach reference"), thereby advancing prosecution.

Present amendments are only to claims as previously presented, by canceling claims or incorporating limitations of claims into the independent claim.

Claims 49, 52 and 55-58 are pending. Claims 1-48, 50-51, 53-54 and 59 have been canceled.

Drawings

The drawings are objected to under 37 CFR 1.83(a).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are submitted herewith, in reply to the Office Action objection. No new or amended drawings are submitted, only original drawings on substituted sheets clearly showing the renumbering of the figures. The drawings are labeled "Replacement Sheet" with the serial number in the top margin.

Applicant submits that the substitute drawings are proper and request that they be admitted to the case.

35 U.S.C. 112, first paragraph

Claims 25-27, 29-42, 44-48, 53 and 54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

These claims are canceled by amendment herewith, thereby obviating this rejection.

35 U.S.C. 112, second paragraph

Claims 48 and 59 are rejected under 35 U.S.C. 112, second paragraph.

These claims are canceled by amendment herewith, thereby obviating this rejection.

35 U.S.C. 102(b)

Claims 25-27, 29-42 and 44-48 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,236,350 to Hasselbach.

These claims are canceled by amendment herewith, thereby obviating this rejection.

35 U.S.C. 103(a)

Claims 49 and 55-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,236,350 to Hasselbach.

It is submitted that Hasselbach provides each of the elements of these claims except for specifying that the slope of the end portions toward the apex is at angle of between about 35 and about 65 degrees, and that to have made the angle of sidewalls slope relative to the base in the claimed ranges would have been an obvious choice of design at the time of the invention to one having ordinary skill in the art.

It is further asserted that this would have been obvious as Hasselbach recites at column 3, line 7 that the end walls slope upwardly and slightly inwardly (emphasis

added). The examiner states that this teaching, in combination with the angle of the slope illustrated within the figures would suggest at the least the slope of about 65 degrees to about 85 degrees relative to the base which would meet the claimed ranges.

Applicant respectfully disagrees. To establish a *prima facie* case of obviousness, the prior art reference must teach or suggest all the claim limitations, there must be some motivation or suggestion to combine the references, and there must be a reasonable expectation of success. See MPEP § 2142, "Establishing a *prima facie* case of obviousness." Hasselbach does not provide motivation to angle the side walls to an angle of between 35 and 65 degrees relative to the base.

Unlike the claimed building skylight, which is designed to maximize light capture, the seedling greenhouse tray cover of Hasselbach is part of an improved, durable greenhouse tray designed to optimize water distribution and seedling growth. Hasselbach teaches away from angling the side walls as such angling would be impractical and would compromise the goal of maximizing seedling growth. Figure 5 of Hasselbach shows a seedling situated at the edge of the seedling tray. If the side wall sloped toward the base at an angle greater than that shown in the figure, it would substantially restrict the area of the base 11 which can be used for the seedling grid 13, as an angled cover would interfere with the growth of seedlings located at or along the edges of the grid.

In addition, as noted in Applicant's previous comments, according to MPEP § 2141.01 (a), in order to rely on a reference as the basis for an obviousness rejection, "the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." (Citations

omitted.)" See also, *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992). In newly added Claims 49-59, the building skylight limitation is part of the claim body rather than part of the preamble.

As previously noted Applicant's argument that Hasselbach is nonanalogous art, as it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention, is not germane to a 35 USC 102(b) anticipatory rejection. See MPEP 2131.05. Applicant's argument that Hasselbach does not teach angling the side walls is not found persuasive as noted in the above rejection Hasselbach teaches a slight slope.

The Office Action states that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Here, in addition to Hasselbach being not adapted to be attached to the roof of a building, its intended use also results in numerous structural differences from the claimed invention. Far from being adapted as a structural element for attachment, the flange 32' of Hasselbach is intended to rest on a seeding tray, and support in this fashion an insubstantial weight of a small seed tray lid.

For the above reasons, withdrawal of the rejection under 103(a) is respectfully requested.

Double Patenting Rejection

Claims 49, 52 and 55-58 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. D-489,462, for the stated reason that although the conflicting claims are not identical.

While the examiner believes the inventions are not patentably distinct from each other, no claim is presently allowed in the application. Further prosecution may change the claims language or scope, such that an evaluation of double patenting can not be made at this time. Furthermore, the I

Should prosecution lead to patentable subject matter that conflicts with claim 1 of U.S. Patent No. D-489,462, Applicant is prepared to submit a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) to overcome an actual rejection based on the nonstatutory double patenting ground.

Conclusion

Based on the foregoing amendments and remarks, Applicant respectfully submits that the application is now in condition for allowance and respectfully requests that the Examiner pass this application to issue.

Applicant has attached the fee for extending the time for response for three months, namely, a check in the amount of \$510. Any additional required fees may be charged to deposit account 50-2767.

If the Examiner has any questions regarding this communication or feels that an interview might facilitate prosecution of the application, he is invited to contact the undersigned at (916) 325-5814.

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Respectfully submitted,

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